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REMARKS

Status of the Claims

Claim 1 has been amended to narrow the scope of possible combinations for the presence or absence of urethane and urea from the originally filed claims and has incorporated the limitation of claim 3. Claim 7 has been added.

Claims 1-7 are now pending. It is believed that no new matter has been added.

Response to Same Invention Double Patenting Rejection

With the above amendments (and the amendments made to the claims of SN: 10/185,523), the two sets of claims no longer claims the same scope of invention. Should an obviousness-type double patenting be the only issue preventing allowance of the claims, the Examiner is requested to contact the undersigned to inquire about the filing of a terminal disclaimer or whether the '523 application can be expressly abandoned.

35 U.S.C. 112, second paragraph rejection

- (1) Claim 1 was stated to be vague and indefinite because the definition of the variables R^1 , R^2 and R^3 could possible read upon compounds which are not "alkoxysilyl-functional polyethers". However, this is incorrect because the "R" variables are not essential to create the "alkoxysilyl" functionality, i.e. it is the link between the polyether and the silyl group that causes the "alkoxy" functionality (e.g. $\text{HO}-(\text{CH}_2-\text{CH}_2-\text{O})_n-\text{CH}_2-\text{CH}_2-\text{O}-\text{SiR}^1\text{R}^2\text{R}^3$).
- (2) The applicants respectfully present that no units are necessary for use of the term "percent" in claims 1 and 7 because the claim must be considered as a whole and cannot be read in isolation, i.e. the claim is directed to a polyether compound with an average molecular weight (M_n) of 800 to 20,000 and as such one of ordinary skill in the art would be able to determine that the compound is polymer of some sort. The percentages referred to in the claim merely reflect the relationship of the number

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of monomers which make up the polymeric compound. It is unclear from the Examiner's explanation why one of ordinary skill in the art would find the applicants' expression to be vague and indefinite.¹

The applicants could perhaps include the phrase "based upon the total number of monomers" but this would appear to be superfluous to one of ordinary skill in the art.

Allowable subject matter

Although not specifically mentioned, it was presumed by the applicants that claim 3 would be allowable if rewritten in independent form as no prior art rejections were cited against it. As claim 1, now includes this limitation, it is believed that claims 1-7 should now be held to be allowable.

35 U.S.C. 102(b)/103(a) rejection

Claims 1, 2, 4 and 5 as originally filed were rejected as being anticipated or in the alternative as being obvious over either Lübbers et al. (U.S. Patent 5,739,245 - hereafter referred to as "Lübbers") or Müller et al. (U.S. Patent 5,118,290 or EP 0 269 819 - hereafter referred to as "Müller").

102(b) portion of rejection

In order to establish/maintain a rejection based on anticipation, every element of the applicants claim must be found in a single reference and the identical invention identical must be shown in as complete detail as is contained in the claim. See MPEP 2131. With the applicants current amendment, both the Lübber and Müller reference no longer meets this criteria, i.e. Lübber and Müller always teach a composition which contains both urethane *and* urea. In the applicants' amended claim, at least one of urethane or urea is *not present* in the composition.

¹ MPEP 2173.02 states that "[t]he examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph is whether the claim meets the threshold requirements of clarity and precision, *not whether more suitable language or modes of expression are available*. When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. *Examiners are encouraged to suggest claim language to applicants to improve clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.* (see MPEP 2173.02)

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With respect to Lübbers, this reference is further distinguished from the claims (even unamended) in that the silyl portion of their compound differs from the applicants' silyl portion, i.e. at least one of R^1 , R^2 and R^3 of Lübbers' compound must be a group of formula V (see e.g. col. 1, lines 40-55) whereas the applicants claim makes no such recitation.

103(a) portion of rejection

Although the Examiner did not have an opportunity to address the limitations made in the claims above in the first Office Action on the merits, the applicants would like to point out that there is no teaching or suggestion within either Lübbers or Müller to eliminate a non-optional element of their respective inventions (i.e. removing either the urethane or urea component of their compositions)

35 U.S.C. 103(a) rejection

Claims 1, 2 and 4-6 as originally filed were rejected as being anticipated or in the alternative as being obvious over either Lübbers et al. (U.S. Patent 5,739,245 - hereafter referred to as "Lübbers") or Müller et al. (U.S. Patent 5,118,290 or EP 0 269 819 - hereafter referred to as "Müller"). As the rejection of claims 1, 2, 4, 5 and 7 were addressed above, it is believed that this rejection pertained primarily to claim 6. With respect to claim 6, the applicants concede that obviousness with respect to this claim would stand or fall with the obviousness of the remaining claims under consideration.

Closing

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,

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